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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/059,421

01/31/2002

Tetsuo Shibuya

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11/08/2005

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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/059,421

Applicant(s)

SHIBUYA ET AL.

Examiner

Cheyne D. Ly

Art Unit

2168

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

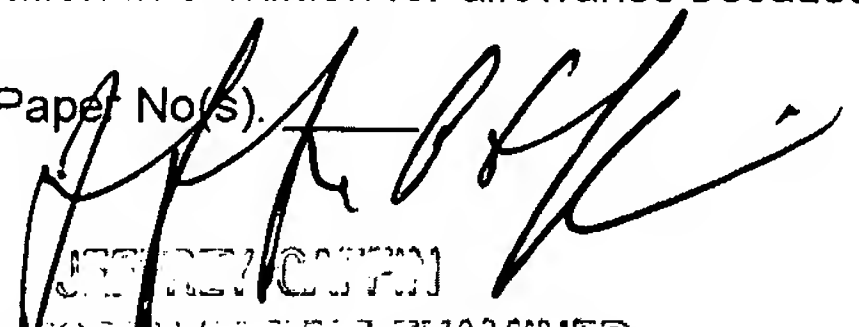
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-29.  
Claim(s) withdrawn from consideration: 30.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

  
\_\_\_\_\_  
EXAMINER

Continuation of 3. NOTE: It is noted that the amendment of "genomic DNA sequence" has raised new issues that would require further consideration and/or search; therefore, the claim amendments have not been entered.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 16-20, 22, and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory algorithm type subject matter.

This rejection is maintained with respect to claims 16-20, 22, and 23, as recited in the previous office action mailed July 25, 2005.

It is noted that instant rejection has been maintained because of the non-entry of the claim amendments as discussed above. However, the proposed amendment would overcome the instant rejection if the amendments were entered.

Claims 1-6, 9-11, 13-21, 23, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al. (December 2000).

This rejection is maintained with respect to claims 1-6, 9-11, 13-21, 23, and 27-29, as recited in the previous office action mailed July 25, 2005.

It is noted that instant rejection has been maintained because of the non-entry of the claim amendments as discussed above. However, the proposed amendment would overcome the instant rejection if the amendments were entered.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (December 2000) taken with Rigoutsos et al. (1998).

This rejection is maintained with respect to claims 1-29, as recited in the previous office action mailed July 25, 2005.

It is noted that instant rejection has been maintained because of the non-entry of the claim amendments as discussed above. However, the proposed amendment would overcome the instant rejection if the amendments were entered.

Continuation of 13. Other:

On page 8, Applicant states "at the interview, the Examiner conceded that the cited references (e.g. Nishikawa) does not appear to teach or suggest the claimed invention." In regard to the interview on October 12, 2005, Examiner Ly discussed the basis for said prior art rejection in regard to Nishikawa et al. Inventor, Rigoutsos, discussed that Nishikawa et al. is distinct from the claimed invention because the method of Nishikawa et al. starts with cDNA while the claimed invention starts with genomic DNA. The Examiner was able to weigh the evidence presented by the inventor and pointed out that claim 1 recites "a DNA sequence," which reasonably includes cDNA as cited in Nishikawa as well genomic DNA. Applicant agreed to explore the potential of amending the claim to recite "genomic DNA." Examiner Ly reminded Applicant that the status of the application is after final. Any amendment that requires further consideration and/or search would not be entered.

On pages 10-11, Applicant argues that the Examiner has "failed to support his restriction of claim 30 from prosecution." Applicant's argument is not persuasive because, as presented in the previous Office Action, mailed July 25, 2005, newly submitted claim 30 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The last three lines of claim 30 recite "after determining whether said open reading frame includes a putative gene, said processor analyzes a next open reading frame in said DNA sequence." While, the examined invention, as originally filed, is directed to "a processor which translates an open reading frame (ORF) of said DNA." Further, claim 2 recites the limitation of "said processor translates a plurality of open reading frames." However, the translation of plurality of open reading frames in claim 2 is not dependent on whether an open reading frame includes a putative gene as required by claim 30. Therefore, new claim 30 recites limitations which cause said claim to be distinct from the examined invention. The distinct critical limitations of claim 30 from the examined invention supports the undue search burden if they were examined together.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 30 has been withdrawn from consideration as being directed to a non-elected invention as originally filed. See 37 CFR 1.142(b) and MPEP § 821.03.

CNL  
11/04/05